

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: October 27, 2008

Signature: 

(David A. Gass)

Docket No.: 28079/41785
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David A. Fischhoff et al.

Application No.: 08/434,105

Confirmation No.: 2627

Filed: May 3, 1995

Art Unit: 1638

For: SYNTHETIC PLANT GENES AND
METHOD FOR PREPARATION

Examiner: A. R. Kubelik

INFORMATION DISCLOSURE STATEMENT (IDS)

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 CFR 1.56, 1.97 and 1.98, the Applicant requests that the Patent and Trademark Office (PTO) consider the documents that are listed on the attached PTO/SB/08 during the prosecution of this application, and make them of record, to appear among the "References Cited" on any patent to issue therefrom.

Documents C313-C321 in this IDS were identified by a third party as purportedly "very relevant information" in the context of related U.S. Patent Application Serial No. 10/102,469. Specifically, the documents were sent to the undersigned attorney by an attorney, George Pazuniak, who is counsel for one of Applicant Monsanto's competitors in the marketplace. (See Document C312, copy of Pazuniak's letter) The attorney who sent the documents was apparently monitoring prosecution of the '469 application and transmitted the documents to the undersigned attorney after the PTO had issued a notice of allowance in the '469 application (when the '469 application was no longer in active prosecution).

The Applicant disagrees with Mr. Pazuniak's assessment that the Patent Office has not yet considered the relevance of the information provided by Mr. Pazuniak.

For example, the documents pertain to a European opposition proceeding, and the various prior art documents referenced in these materials from the European proceeding are already of record, as summarized in the following table:

Citation	Notice of Opposition (OII)	Letter from Syngenta dated April 11, 2002	Appendix A (OI)	Appendix B	Previously cited in U.S. case 08/434,105 as IDS Cite No.
Adang et al., Molecular Strategies for Crop Protection - Proceedings of a DuPont-UCLA symposium on Molecular Strategies of Crop Protection, Alan R. Liss, Inc. 343-53 (1987).	D4	X		D2	C4
Adang et al., <i>Plant Molecular Biology</i> . 21: 1131-45 (1993).			D2		C5
Aota et al., <i>Nucl. Acid. Res.</i> 16: Suppl. R315-402 (1988).		X	D3		C6
Barton et al., <i>Plant Physiology</i> 85: 1103-9 (1987)	D5	X	D4	D4	C10
Ernst, J. F., <i>Tibtech</i> . 6: 196-9 (1988).	D7				C44
Fischhoff et al., <i>Bio/Technology</i> . 5: 807-13 (1987).		X	D5		C46
Hoekeme et al., <i>Mol. Cell Biol.</i> 7: 2914-24 (1987).		X	D6		C73
Hofte et al., <i>Europ. J. Biochem.</i> 161: 273-80 (1986).	D3				C80
Marked up copy of Figure 3 of D3	D3A				C80
Schnepf et al., <i>J. Bacteriol.</i> 169: 4110-8 (1987).		X	D7		C163
Sharp et al., <i>Nucl. Acid. Res.</i> 14: 5125-43 (1987).		X	D8		C166
Vaeck et al., <i>Nature</i> . 328 (6125):33-7 (1987).	D2	X	D9	D9	C188
Walker, Declaration of Keith A. Walker 37 C.F.R. § 1.132 filed on June 10, 1991 before the United States Patent and Trademark Office.			D14		
European Patent Application 0 275 957	D6				B14
European Patent Application 0 359 472	D1	X	D1	D1	B20
Marked up copy of Figure 1 of D1	D1A		D1A		B20

Nonetheless, Monsanto (in keeping with its duty of candor and good faith), wants to insure that the Examiner has considered evidence that even Monsanto's competitor, in this instance, alleges to be material to the Examiner determination of patentability before the Examiner reaches a final determination of patentability. (The Walker declaration, not previously of record or supplied by Mr. Pazuniak, is included here as IDS document C322 because it was cited in the supplied opposition documents.)

Applicant submits herewith copies of non-patent literature in accordance with 37 CFR 1.98(a)(2).

In accordance with 37 CFR 1.97(h), the filing of this Information Disclosure Statement shall not be construed to be an admission that any patent, publication or other information referred to therein is "prior art" for this invention.

This IDS is filed more than three months after the U.S. filing date, AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Office Action or Notice of Allowance (37 CFR 1.97(c)). Accordingly, the fee associated with 37 C.F.R. § 1.17 is submitted herewith. However, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 28079/41785.

Dated: October 27, 2008

Respectfully submitted,

By 
David A. Gass

Registration No.: 38,153
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant